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### **REMARKS**

Claims 147, 148 and 153 were pending in the subject application. By this Amendment, applicants have amended claims 148 and 153. Accordingly, upon entry of this Amendment, claims 147, 148 and 153, as amended, will be pending and under examination.

Applicants maintain that the amendment to claim 148 to delete the term "specifically" raises no issue of new matter. Likewise, the deletion of the word "or" in claim 153 raises no issue of new matter.

Accordingly, applicants respectfully request that the Amendment be entered.

### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

On page 2 of the July 12, 2004 Office Action, the Examiner rejected claim 148 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleged that claim 148 is indefinite because it is not clear when compounds "specifically bind" to a human Y4 receptor as compared to when they only "bind" to a human Y4 receptor.

The Examiner also rejected claim 153 for allegedly being dependent on an indefinite base claim.

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In response, in an attempt to advance the prosecution but without conceding either the need for amendment or the correctness of the Examiner's position, Applicants have amended claim 148 to delete the term "specifically".

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

**Rejection Under 35 U.S.C. § 112 first paragraph**

On page 3 of the July 12, 2004 Office Action, the Examiner rejected claims 147-148 and 153 under 35 U.S.C. 112, first paragraph alleging that while the specification is enabling for a method of obtaining a composition which comprises determining whether a chemical compound binds to a human Y4 receptor expressed on the surface of a mammalian cell transfected with a vector adapted for expressing the receptor in the cell, wherein the human Y4 receptor has an amino acid sequence identical to the amino acid sequence shown in SEQ ID NO: 2, the specification does not reasonably provide enablement for the use of the human Y4 receptor which is encoded by the nucleic acid sequence identical to the receptor-encoding nucleic acid sequence contained in plasmid pcEXV-Y4 (ATCC Accession No. 75631).

The Examiner further alleged that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The Examiner then stated that the deposit of biological materials is considered to be necessary for the enablement of

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the current invention and that the deposit of plasmid pcEXV-Y4 (ATCC Accession No. 75631) is allegedly not in compliance with 37 CFR §§ 1.803-1.809.

In response, applicants' undersigned attorney states herewith that in accordance with 37 C.F.R. §1.808(a)(2) all restrictions imposed by the depositor on the availability to the public of the deposited materials will be irrevocably removed upon the granting of a patent from the subject application. Applicants transmit herewith a copy of the ATCC Deposit Receipt for plasmid pcEXV-Y4 (ATCC Accession No. 75631), indicating that the deposit was made under the terms of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure on December 23, 1993.

Applicants also note that the date of the deposit, the complete name and address of the depository, and the accession number of the deposited plasmid can be found in the specification on page 19, line 32 through page 20, line 20.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 112, first paragraph.

In summary, in view of the foregoing amendments and remarks, applicants respectfully request that the Examiner reconsider and withdraw the grounds for rejection set forth in the July 12, 2004 Office Action and earnestly solicit allowance of the claims now pending, namely, claims 147, 148 and 153.

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If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone the number provided.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 50-3201.

Respectfully submitted,



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